

REMARKS

At the time of the Non-Final Office Action dated June 23, 2009 (the Fourth Office Action), claims 1, 4, 5, 7-9, 12, 13, 15-17, 20, 21, 23 and 24 were pending in this application. Claims 1, 4, 5, 7-9, 12, 13, 15-17, 20, 21, 23 and 24 were rejected, and claims 7, 8, 15, 16, 23 and 24 were objected to as depending from rejected claims. Claims 7, 8, 15, 16, 23 and 24 were indicated as being allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 101, set forth in the Fourth Office Action and including all the limitations of the base claim and any intervening claims.

CLAIMS 17, 20-21 AND 23-24 ARE REJECTED UNDER 35 U.S.C. § 101

On page 3, paragraph 3 of the Fourth Office Action, the Examiner asserted that the claimed invention, as recited in claims 17, 20-21, 23-24, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

Claim 17

Independent claim 17 has been amended to clarify that the claim is directed to a data transformation tool of a computer system. Independent claim 17 has been amended to recite that the data transformation utility, the data matching utility and the data loading utility are all executed in memory by a processor of a general purpose computing system. As such, at the very least, independent claim 17 is tied to a machine and meets the 'machine or transformation' test described within In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc). In addition, Figure 1 of Applicants' disclosure clearly illustrates that the claimed invention is embodied in hardware.

Reference is also made to paragraph [0031], lines 4-12 of Applicants' disclosure. Applicants respectfully submit that claim 17 (and those claims dependent upon claim 17) are directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

THE REJECTION OF CLAIMS 1, 4-5, 9, 12-13, 17 AND 20-21 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON U.S. PATENT NO. 6,016,501 TO MARTIN, ET AL., (HEREINAFTER MARTIN) IN VIEW OF U.S. PATENT NO. 6,985,905 B2 TO PROMPT, ET AL., (HEREINAFTER PROMPT) AND IN FURTHER VIEW OF U.S. PATENT NO. 6,978,115 B2 TO WHITEHURST, ET AL., (HEREINAFTER WHITEHURST)

On pages 4-7, of the Fourth Office Action, the Examiner concluded that one of ordinary skill in the art would have been impelled to modify Martin in view of Prompt in further view of Whitehurst to arrive at the claimed invention. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon viewing the Examiner's analysis with the First Office Action, the Examiner has failed to identify any of the above-described rationales. If the Examiner is to maintain the present rejection, Applicants request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

For example, as discussed on page 57,534 of the Examination Guidelines, if the Examiner is to rely upon rationale (G), the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

(A) Determine the scope and content of the prior art;

(B) Ascertain the differences between the prior art and the claims at issue;

(C) Resolve the level of ordinary skill in the pertinent art; and

(D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

The Examiner, however, has failed to perform much of this analysis. As such, the Examiner has not established a prima facie case of obviousness.

At page 4, the last full paragraph of the Third Office Action, the Examiner asserted:

Examiner provided Martin which discloses a data transformation from a source database to a target database. The data such as "learning process" or "LMS" or "user information" or "course information" or an (e-learning model" are just data which were disclosed by Martin.

The failure of the Examiner to consider the limitations of "learning process", "learning management system", "LMS", "user information", "course information" and "e-learning model" is clear reversible error. First, as is known to one of reasonable skill in the art, a "learning management system" (LMS) is an application or Web-based technology used to plan, implement, and assess a specific learning process. Typically, a learning management system provides an

instructor with a way to create and deliver content, monitor student participation, and assesses student performance. A learning management system may also provide students with the ability to use interactive features such as threaded discussions, video conferencing, and discussion forums. Thus, the Examiner has erroneously identified the “learning management system” or “LMS” as “just data”.

In the first and second paragraphs on page 3 of the Fourth Office Action, the examiner responded to the Applicants’ above argument:

Applicant argues ““learning management system” (LMS) is an application or a Web-based technology used to plan, implement access the learning process...”

Examiner respectfully disagrees with the above argument. Martin also includes a software process to convert the data from one source to a target. Such application is also consider being an application as applicant recited. Secondly, “learning management system” (LMS) cannot be interpreted as Web-based technology because applicant has not claimed this feature as web-based technology.

Applicants provided the Examiner, the proper construction of the term “LMS” as would be understood by one of reasonable skill in the art at the time of the invention to rebut the Examiner’s assertion that the “learning management system” or “LMS” were “just data”. By misconstruing the terms “learning management system” and “LMS” as being just data, the Examiner has failed to establish a *prima facie* case of obviousness.

Similarly, as is known to one of reasonable skill in the art, e-learning models are attempts to develop frameworks to address the concerns of the learner and the challenges presented by the technology so that online learning can take place effectively. New e-learning models are continually emerging as new research findings in the area of e-learning become available. Thus, the Examiner has erroneously identified the “e-learning models” as “just data”.

1 Accordingly, the Examiner has failed to designate the teachings in Martin, Prompt and
2 Whitehurst being relied upon to state the rejection. In this regard, the Examiner's rejection under
3 35 U.S.C. § 103 fails to comply with 37 C.F.R. § 1.104(C). Thus, Martin, Prompt and
4 Whitehurst fail as references to sufficiently establish a *prima facie* case of obviousness.
5 Applicant, therefore, respectfully submits that the imposed rejection of claims 1, 4-5, 9, 12-13, 17
6 and 20-21 under 35 U.S.C. § 103 for obviousness based upon Martin in view of Prompt and
7 Whitehurst is not viable, and hence, Applicants solicit withdrawal thereof.

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Applicants have made every effort to present claims, which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Respectfully submitted,

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